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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,369	02/23/2004	Philip R. Raymond	Vanquish 1div	8906

7590 03/24/2006
Gregory P. Gadson, Esq.
19375 Amber Way
Noblesville, IN 46060

EXAMINER

WOO, STELLA L

ART UNIT PAPER NUMBER

2614

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/784,369	RAYMOND, PHILIP R.	
	Examiner	Art Unit	
	Stella L. Woo	2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 5 and 6 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 2 of prior U.S. Patent No. 6,697,462. This is a double patenting rejection.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims

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an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 and 17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 5 of U.S. Patent No. 6,697,462 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims in the present application are broader than the ones in the patent, *In re Van Ornum and Stang*, 214 USPQ 761. For example, claim 1 of the present application is the same as claim 1 of the patent except that it does not recite steps g and h. Therefore, claim 1 of the present application is broader than claim 1 of the patent. Claim 17 of the present application is the same as claim 5 of the patent except that it does not recite "a counter adapted to, for each sender encountered by the system, counting the number of communications by the sender which are rejected by the recipient." Therefore, claim 17 of the present application is broader than claim 5 of the patent.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent

or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 7-13, 15-20, 23-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Abkemeier (US 2003/0023736 A1).

Regarding claims 1, 17, Abkemeier discloses a method of regulating electronic communications, said method comprising the steps of:

a) receiving a communication from a sender for a designated recipient (Recipient's Message Processing Equipment 25 receives an electronic message from sender 10; Figure 4, step 42);

b) comparing sender identity indicia attached to said communication with stored sender identity indicia in a database under the control of said recipient (Authorization Filter determines if the message is authorized by comparing with a sender-based whitelist defined and managed by the individual message recipient; Figure 4, step 43; paragraphs 35-36);

c) presenting said communication to said recipient for acceptance or rejection, when said sender identity indicia is determined to be acceptable in step b) (message is delivered by the authorization filter for receipt by the recipient when the message is determined to be authorized; Figure 4, step 45);

d) sending a return message to said sender indicating that a bond must be posted when said sender identity indicia is not determined to be acceptable in step b), and that money associated with said bond shall be forfeited if said

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communication is presented to said recipient and said recipient rejects said communication (if the message is determined to be unauthorized, an unauthorized message notification is returned to the sender as well as a notification of authorization terms which could require a deposit of money in an escrow account, the money being forfeited when the recipient chooses not to grant authorization; Figure 4, steps 47 and 52; paragraphs 59, 66);

e) dissolving said bond when said recipient accepts said communication (escrow items are generally returned to those senders granted authorization by the recipient; paragraph 66, last sentence);

f) causing the money associated with said bond to be forfeited when said recipient rejects said communication (escrow items are kept from those senders not granted authorization by the recipient; paragraph 66, last sentence).

Regarding claims 2, 18, the escrow proceeds can be provided to an independent third party designated by the recipient, such as a school, a charity, etc. (paragraph 74, last sentence).

Regarding claims 3, 19, communication can take place via a WAN (paragraph 46).

Regarding claims 4, 20, the amount of money is set by the individual message receiver (paragraph 59, lines 15-16; paragraph 67, last sentence).

Regarding claims 7-11, 23-27, the communication can be any type of communication including email, instant messaging, real-time voice communication, etc. (paragraph 74).

Regarding claims 12, 28, a sender can immediately request authorization without waiting to get a notification that they are unauthorized (Figure 5; paragraph 67).

Regarding claims 13, 29, Abkemeier provides for various whitelist filters which would result in message delivery (paragraph 39).

Regarding claims 15-16, 30-31, the escrow process can take place at the email service provider or a separate company which will only handle the escrow process (paragraph 74).

7. Claims 32-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Landesmann (US 2005/0144244 A1).

Regarding claims 32 and 34, Landesmann discloses a method of regulating electronic communications, said method comprising the steps of:

receiving a communication from a sender for a designated recipient (sender sends email for a designated recipient via an intermediary email box system; Figure 2, step 200);

if said communication is accompanied by a posted bond (sender sends email with a deposit; Figure 2, step 204), the amount of which is specified by said recipient (during setup, recipient selects the deposit threshold; Figure 3, step 320; paragraph 75), the recipient providing a guarantee that said communication will be accepted (when the deposit has been verified and equals or exceeds the pre-set threshold, the message is sent to the primary inbox of the recipient and opened by the recipient; Figure 2, steps 220, 240, 250).

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Regarding claims 33 and 35, communication can take place between telephones (paragraph 52).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abkemeier in view of Council et al. (US 6,587,550 B2, hereinafter "Council").

Abkemeier differs from claim 14 in that it does not teach enabling a recipient to declare himself/herself willing to receive commercial communications from senders approved by the system and paying a recipient who agrees to receive said commercial communications a fee from said sender. However, Council, from the same field of endeavor, teaches the desirability of allowing email communications from authorized sending parties with whom an agreement to an advertising fee is made (see claim 13) such that it would have been obvious to an artisan of ordinary skill to incorporate such receipt of commercial messages in exchange for advertising fees, as taught by Council, within the method of Abkemeier so that email recipients can choose to receive commercial messages from select advertisers and be monetarily compensated.

10. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abkemeier in view of Landesmann.

Abkemeier differs from claim 21 in that it does not teach the deposit expiring after a predetermined time. However, Landesmann, from the same field of endeavor, teaches the desirability of an expiration date (paragraph 62) such that it would have been obvious to an artisan of ordinary skill to incorporate such use of an expiration date, as taught by Landesmann, within the method of Abkemeier in order to restrict the time period during which a deposit can be accepted or declined.

Abkemeier differs from claim 22 in that it does not specify transmitting a confirmation message to a recipient. However, Landesmann teaches the desirability of sending a confirmation message which indicates whether or not the deposit has been returned or accepted (paragraph 72) such that it would have been obvious to an artisan of ordinary skill to incorporate such transmission of a confirmation message, as taught by Landesmann, within the the method of Abkemeier.

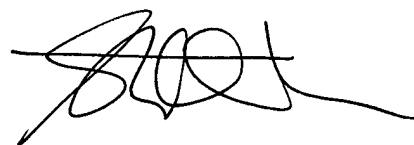
Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kanaya, Council (US 6,192,114), Council (US 6,483,910) and Partridge, III show other relevant systems which require payment for receiving communications.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella L. Woo whose telephone number is (571) 272-7512. The examiner can normally be reached on Monday-Friday, 8:00 a.m. to 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Stella L. Woo', with a long horizontal line extending to the right.

Stella L. Woo
Primary Examiner
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